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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,976	01/31/2001	Paul Sun	87165-9051	6280
23510	7590	10/30/2003	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP ONE SOUTH PINCKNEY STREET P O BOX 1806 MADISON, WI 53701			FOX, DAVID T	
			ART UNIT	PAPER NUMBER
			1638	

DATE MAILED: 10/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/773,976

Applicant(s)

SUN ET AL.

Examiner

David T. Fox

Art Unit

1638

--Th MAILING DATE of this communication appears on the cover sheet with th correspondence address --

THE REPLY FILED 05 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 05 September 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☒ Applicant's reply has overcome the following rejection(s): 112 second paragraph, 112 first re deposit.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-9.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 5. does NOT place the application in condition for allowance because: arguments are duplicative of those previously presented and addressed.

Re 112 first for molecular markers, the markers disclosed in the spec are only useful for determining the parentage of progeny from a particular cross, or for determining the hybridity of the parents used, but are not generally useful for determining the hybridity of the progeny, as stated earlier and on page 8 of the first office action.

Re 102, page 8 of spec clearly states that 'Thor' was one parent, and the art of record states that 'Thor' is a synthetic, as stated previously. Applicants' assertions that 'Thor' is not a synthetic are not persuasive in view of the art cited. The progeny of a cross between a heterogenous population, namely a synthetic, would necessarily be a heterogenous synthetic population itself, unless only one plant of the synthetic was chosen. Applicants' spec has provided no guidance as to which plant from the synthetic population of 'Thor' was selected, and has provided no guidance regarding the genotype of the other parents. Therefore the claimed alfalfa hybrid designated as DS 9705Hyb appears to be a synthetic hybrid. See also pages 15-17, 21-22 of the spec, Tables 9, 11, 13, 21 and 23, where "DS 9705Hyb" is designated as "Syn" for synthetic, and wherein this variety exhibits non-uniform trait expression, as evidenced by the 25-75% of the population which exhibit resistance to a particular pathogen, wherein said non-uniform trait expression is characteristic of a synthetic variety which is comprised of a population of different genotypes.

Furthermore, although claim 2 has been amended to indicate that the plants are grown from the deposited seed or are otherwise not a progeny of the plant crossed with something else, the claim still reads on a single plant which would encompass the "Thor" parent of the synthetic population. Note also that claim 2 reads on somaclonal variants, since it has been amended to encompass plants grown from tissue culture or callus, which are known to generate somaclonal variants which do not have the same genotype or phenotype as the plants from which they were obtained.

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180/1638

